

**REMARKS/ARGUMENTS**

This letter is responsive to the final office action dated August 19, 2008.

In the office action, the Examiner rejected claims 1, 5-14, 23, 27-36, and 45-46 under 35 U.S.C. 103(a) as being obvious in view of U.S. Patent No. 7,216,072 in the name of Kasai et al. ("Kasai"). The Applicants respectfully traverse all rejections.

At page 3 of the office action, the Examiner states that:

"In response to applicant's arguments, it is known to a person skilled in the art that **emails can be sent in several formats including HTML**. And because of the high versatility of HTML, a person skilled in the would certain consider this language to solve the problem of translation of **emails using different formats** in Kasai's fourth embodiment. The user of HTML is therefore considered as an obvious choice of options to a person skilled in the art." (emphasis added)

If it were known that "emails can be sent in several formats including HTML", at best, this would suggest that the **mail messages** to be translated as received at mail server 31 and sent to translated mail server 32 might be in HTML. There is no suggestion that the communications subsequently transmitted from the translated mail server 32 to the translation server 33 would also be in HTML. Kasai explicitly teaches at column 21 lines 45-46 that, subsequently, the "translated mail server 32 sends the text information to the translation server 33 and requests the server 33 to translate it" (emphasis added).

Accordingly, even if Kasai did disclose that the translated mail server 32 does "some sort of format conversion for the translation server" as suggested by the Examiner (which the Applicants do not concede), this could only suggest that, at best, the formatting performed by the translation mail server 32 in Kasai would be from HTML to text in order that text may be provided to the translation server as clearly taught by Kasai, but **not from text to HTML as claimed.**

It is notable that Kasai only teaches that the translation server 33, which the Examiner asserts is analogous to the Applicant's claimed processing server, is able to receive text. No suggestion is made in Kasai with reference to either the fourth or fifth embodiments that the translation server 33 itself may be configured to receive non-text input, such as HTML input. In fact, Kasai does not provide any teaching, suggestion or motivation that the type of translation server 33 to be used in the system 1 may be modified, nor does Kasai provide any teaching, suggestion or motivation that the formatting functions of the proxy server 32 could or should also be modified accordingly.

As previously noted, by separating the HTML conversion functionality with the further processing (e.g. translation) functionality on different servers, existing HTML processing servers (e.g. Internet translators) may be employed to reduce implementation costs. This is not given any consideration in Kasai.

Generally, it may be permissible to refer to an "obvious choice of options" or "design choice" in some situations. These situations, however, require the existence of an evidentiary record. See In re Chu, 36 USPQ2d 1089 (Fed. Cir. 1995) (**there must be evidence in the record to support the notion that there is indeed a design choice and that one skilled in the art would be motivated to modify a reference to make that choice**). Mere assertion of words such as "design choice", however, do not give the Examiner the capability to circumvent having to prove a teaching, suggestion or motivation. If there is no teaching,

suggestion or motivation supported by the record, then that problem is fatal, and the Examiner is not permitted to cure that problem merely by using the words "obvious design choice". In re Dembicza, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).

It is respectfully submitted that the record does not support the notion that there is indeed a design choice to be made. It is insufficient to show that it might be obvious to "use HTML" generally, or to show that the contents of mail messages might be presentable in HTML format. There is no suggestion in Kasai that text to HTML formatting is to be performed at the proxy in order to accommodate a translation server that requires HTML input. As previously noted, Kasai clearly teaches away from this.

In the office action, it appears that the Examiner has asserted that the skilled person would be motivated to modify Kasai. For the foregoing reasons, the Applicants respectfully disagree. The Applicants note that the Supreme Court's KSR decision<sup>1</sup> did not reject the use of a "teaching, suggestion or motivation" analysis as part of an obviousness analysis. The Supreme Court characterized the analysis as a helpful insight. It is respectfully submitted that the absence of a teaching, suggestion or motivation is a significant point in the Applicants' favor, as this absence is indicative of non-obviousness.

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Although the Supreme Court did not reject use of a "teaching, suggestion or motivation" analysis, the Supreme Court did say that it was not the only possible analysis of an obviousness question. In the event that the Examiner chooses to pursue a different avenue for rejection, the Examiner is invited to explicitly identify the rationale and articulate the reasons on which such rejection is based, and it should be noted that any new avenue would be a new ground for rejection not due to any action by the Applicants.

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<sup>1</sup> KSR International Co. v. Teleflex, Inc., No. 04-1350 (April 30, 2007)

The Applicants further respectfully reminds the Examiner that, even after KSR, the following legal principles are still valid, having been endorsed by the Supreme Court or having been unaffected by its decision: (1) the USPTO still has the burden of proof on the issue of obviousness; (2) the USPTO must base its decision upon evidence, and it must support its decision with articulated reasoning (slip op. at 14); (3) merely demonstrating that all elements of the claimed invention exist in the prior art is not sufficient to support a determination of obviousness (slip op. at 14-15); (4) hindsight has no place in an obviousness analysis (slip op. at 17); and (5) Applicants are entitled to a careful, thorough, professional examination of the claims (slip op. at 7, 23, in which the Supreme Court remarked that a poor examination reflected poorly upon the USPTO).

Accordingly, the Applicants submit that the subject matter of claims 1, 5-14, 23, 27-36, and 45-46 is not obvious in view of Kasai. Withdrawal of the remaining objections under 35 U.S.C. 103 is respectfully requested.

Yours truly,

BERESKIN & PARR  
Agents for the Applicants

  
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Kendrick Lo  
Reg. No. 54,948  
(416) 364-7311